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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,668	10/12/1999	HIROSHI KAIBARA	1232-4579	5143
7590 03/11/2004 MORGAN AND FINNEGAN LLP 345 PARK AVENUE NEW YORK, NY 10154			EXAMINER WALLERSON, MARK E	
			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/415,668

Applicant(s)

KAIBARA, HIROSHI

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 12-23, 35-49, 51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 5-11, 24-26, 28-34 and 50 is/are rejected.
- 7) ☐ Claim(s) 4 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 17.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 12/29/2003.
2. This application has been reconsidered. Claims 1-52 are pending. Claims 12-23, 35-49, 51 and 52 are withdrawn from consideration.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 3, 6, 7, 8, 9, 24, 25, 26, 29, 30, 31, 32, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Maniwa (U. S. 5,764,866).

With respect to claims 1, 2, 3, 6, 9, 24, 25, 26, 29, 32, and 50, Maniwa discloses an image communication method comprising a transmission step of automatically transmitting plural image files (FILE-1...FILE-n) indicated in a transmission image designation file (131) to an external device (4); a list generation step wherein the image transmitting apparatus generates a list holding information indicative of the transmitted image files and information representing a transmission order of the files (column 16, lines 11-32 and figure 6 (depicts the order of the transmitted files)); the list being named a name different

from that of the transmission image designation file and having a same format as that of the transmission image designation file (column 13, lines 1-17).

With respect to claims 7, 8, 30 and 31, Maniwa discloses the output device is a display device or printer (column 5, lines 48-56).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa in view of Hui (U. S. 6,237,010).

With respect to claims 5 and 28, Maniwa differs from claims 5 and 28 in that he does not clearly disclose the image file is the file name of the image. Hui discloses storing and displaying a list of images, wherein the image file is the file name of the image (column 8, line 40 to column 9, line 35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Maniwa by the teaching of Hui in order to allow the user to easily search for and locate the images.

7. Claims 10, 11, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa in view of Reed (U. S. 6,426,801).

With respect to claims 10, 11, 33, and 34, Maniwa differs from claims 10, 11, 33, and 34 in that he does not clearly disclose the list is generated with a mark format defined in CIFF. Reed discloses a computer readable medium storing graphic files for printing, comprising a digital representation of an image captured by a camera, wherein the graphic file format is a CIFF format (column 6, lines 21-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Maniwa to generate the list with a mark format defined in CIFF. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Maniwa by the teaching of Reed in order to improve storage capabilities.

Response to Arguments

8. Applicant's arguments with respect to claims 1-11, 24-34, and 50 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

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or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON